



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,719	01/30/2001	Jan Zavada	D-0021, 3A-2	1371

24988 7590 10/03/2003
LEONA L. LAUDER
465 CALIFORNIA, SUITE 450
SAN FRANCISCO, CA 94104-1840

EXAMINER

WHISENANT, ETHAN C

ART UNIT	PAPER NUMBER
----------	--------------

1634

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,719

Applicant(s)

ZAVADA ET AL.

Examiner

Ethan Whisenant, Ph.D.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1634

FINAL REJECTION

1. The applicant's Response (filed 02 JUN 03) to the Office Action has been entered. Following the entry of the claim amendment(s), **Claim(s) 48-69** is/are pending. Rejections and/or objections not reiterated from the previous office action are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

35 USC § 112 - 1st Paragraph

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

CLAIM REJECTIONS UNDER 35 USC § 112- 1ST PARAGRAPH

3. **Claim(s) 58** is/are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the instant case, the applicant has disclosed that an increase in MN protein is diagnostic of neoplastic and/or preneoplastic diseases and gives numerous examples including renal carcinoma. In addition there is basis for the patenting of a generic RT-PCR process to detect an increase in MN gene expression, however, there is not explicit elaboration of the claimed RT-PCR (i.e. the primers) to detect an increase in MN gene expression. The examiner has followed the General Principle governing compliance with the written description requirement for applications outlined in the previous office action (i.e. the office action mailed 02 JAN 03).

NONSTATUTORY DOUBLE PATENTING

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. **Claim(s) 48-51** is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-3 of U.S. Patent No. 6,027,887.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 1-3 of U.S. Patent No. 6,027,887 teach all of the limitations of Claims 48-51. Claims 1-3 of U.S. Patent No. 6,027,887 are coextensive in scope with those of Claims 48-51 of the instant application and the granting of as patent thereon would allow the unjustified or improper timewise extension of the "right to exclude" previously granted to the applicant in U.S. Patent No. 6,027,887.

6. **Claim(s) 52-57 and 59-69** is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-3 of U.S. Patent No. 6,027,887 in view of Samid [US Patent No.: 5,605,930 (1997)].

Claims 1-10 of U.S. Patent No. 6,027,887 teach all of the limitations of Claim 52 except this patent's claims do not teach that the nucleic acid based assay is a PCR based assay as recited in Claims 52, however, as RT-PCR (a PCR based assay) and its use to detect abnormal gene expression, was well known at the time of the invention as evidenced by Samid (see the entire paragraph in Column

Art Unit: 1634

110, beginning at about line 15) , it would have been, absent an unexpected result, *prima facie* obvious to one of ordinary skill in the art at the time of the invention to modify the method taught by Claims 1-10 of U.S. Patent No. 6,027,887 with the teachings of Samid. The ordinary artisan would have been motivated to make this modification in order to confirm the results of the assay in Claims 1-10 of U.S. Patent No. 6,027,887 as suggested by Samid.

RESPONSE TO APPLICANT'S AMENDMENT/ ARGUMENTS

7. Applicant's arguments with respect to the claimed invention have been fully and carefully considered but are not deemed to be persuasive.

The applicant presents numerous paragraphs of arguments including reasoning as to why the McKiernan et al. patent [US 6,087,098 (2000)] lacks utility and is not enabled. In response, the examiner must admit that he agrees with the applicant's reasoning, however, all US patents, by law, are presumed valid. Also note that "the burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity."

As regards the declaration of an interference with the claims of the McKiernan et al. patent [US 6,087,098 (2000)], the examiner finds the applicant's arguments unpersuasive. McKiernan et al. is claiming a patentably distinct species which falls within the broader scope of the instant claims and those of US Patent No. 6,027,887, In addition, as regards the presumed count (i.e. Claim 1 of US 6,087,098) of an interference, the applicant's disclosure as originally filed fails to meet the written description requirement of 35 U.S.C. 112, first paragraph. Therefore it would be improper for the examiner to declare an interference.

CONCLUSION

8. Claim(s) 48-69 is/are rejected and/or objected to for the reason(s) set forth above.

Art Unit: 1634

9. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.



**ETHAN WHISENANT
PRIMARY EXAMINER**